

### Remarks

This is in response to the non-final Office Action mailed May 3, 2006. Claims 8, 21, and 34 are cancelled herein without prejudice or disclaimer. Claims 1-7, 9-20, 22-33, and 35-39 remain pending. Reconsideration and allowance are requested in view of the amendments and remarks herein.

#### I. Claim Rejections - 35 U.S.C. § 101

In section 1 of the Office Action, claims 1-39 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The rejection states that the claimed invention fails to produce a useful, tangible, and concrete result. This rejection is respectfully traversed, and reconsideration is requested for the following reasons.

Claim 1 is directed to a method of embedding voice data in a computing system. Claim 1 recites the following:

- detecting a record event;
- detecting if a software application currently running on the computing system is voice-aware;
- if the software application is voice-aware, embedding the voice data within associated data in the software application; and
- if the application is not voice-aware, triggering a voice note application to record and store the voice data.

In order for the invention recited in claim 1 to satisfy section 101, the subject matter must produce a useful, tangible, and concrete result. See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, 1300 Off. Gaz. Pat. Office 142 (Nov. 22, 2005) ("Subject Matter Eligibility Interim Guidelines"). For the following reasons, it is suggested that the invention recited in claim 1 does produce a useful, tangible, and concrete result and therefore is statutory subject matter under section 101.

The subject matter of claim 1 produces a useful result in that the subject matter satisfies the utility requirement of section 101. See MPEP 2107. For example, the claim is directed to a practical application, namely a method of embedding voice data. The claim is directed to a useful result in that the claim recites that the voice data is embedded within associated data in the software application, if the application is voice-aware. In this manner, the voice data can be

associated with the data with which the user is currently working. This can assist in the organization of the voice data for later retrieval. See p. 11, l. 1 of the application.

The subject matter of claim 1 produces a tangible result in that the claim recites a practical application that produces a real-world result. Benson, 409 U.S. at 71-72. For example, claim 1 is directed to a practice application, namely a method of embedding voice data. Claim 1 produces a real-world result in that the claim recites the result of voice data being embedded within associated data in the software application.

The subject matter of claim 1 produces a concrete result in that the method recited by the claim is substantially repeatable to produce the same result. In re Swartz, 232 F.3d 862, 864, (Fed. Cir. 2000). For example, claim 1 recites a method of embedding voice data that is repeatable because the method can be repeated multiple times. In addition, the method recited by claim 1 produces the same result, namely that the voice data is embedded within associated data in the software application (or, if the application is not voice-aware, recorded and stored by a voice note application).

Claim 1 is therefore directed to statutory subject matter for at least these reasons. Claims 2-7 and 9-13 depend from claim 1 and are also directed to statutory subject matter. Although claims 14-20, 22-33, and 35-39 are not of the same scope as claim 1, these claims include similar limitations to those recited in claim 1 and are therefore also directed to statutory subject matter. Reconsideration and allowance of claims 1-7, 9-20, 22-33, and 35-39 are requested.

## II. Double Patenting

In section 3 of the Office Action, claims 8, 21, and 34 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1, 13, and 25, respectively, of U.S. Patent No. 6,720,980. This rejection is respectfully traversed, and reconsideration is requested for the following reasons.

Claims 8, 21, and 34 are cancelled. Reconsideration and removal of the rejection are therefore requested.

In section 4 of the Office Action, claims 1-7, 9-20, 22-33, and 35-39 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,720,980. This rejection is respectfully traversed, and reconsideration is requested for the following reasons.


Attached at the Appendix hereto is a Terminal Disclaimer that addresses this rejection.  
Reconsideration and removal of the rejection are therefore requested.

III. Conclusion

Favorable reconsideration in the form of a Notice of Allowance is requested. If there are any questions regarding this application, please call the undersigned at 612.332.5300.

Respectfully submitted,  
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Date: August 3, 2006

  
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Attachment: Appendix

## APPENDIX

Attached hereto is a Terminal Disclaimer (2 pages).